

REMARKS

At the outset, Applicants wish to thank Examiner Nguyen for the courtesies extended to Applicants' representatives during the April 22, 2003 personal interview. The substance of the personal interview is incorporated in the following remarks.

Summary of the Office Action

Claims 1, 2, and 4 were objected to for certain informalities. Claims 5 and 6 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not supported in the original specification. Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marshall et al.* (U.S. Patent No. 5,626,489) in view of *Hill* (U.S. Patent No. 5,547,388).

Summary of the Response to the Office Action

Applicants propose to amend claims 1 and 5. Accordingly, claims 1, 2, and 4-7 are pending for further consideration.

All Subject Matter is Allowable

Applicants respectfully submit that the proposed amendment to independent claim 1 removing the phrase "an open end and" overcomes the objections to claims 1, 2 and 4. Applicants respectfully submit that the amendment to claim 1 does not create a new issue for consideration and that the claims are in form for allowance.

All Subject Matter Complies with 35 U.S.C. § 112, first paragraph,

The Office Action indicates that claims 5 and 6 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. This rejection is respectfully traversed.

The Office Action takes the position that the term “diameter” is not supported in the specification. As discussed during the personal interview, Applicants hereby remove the objectionable term in independent claim 5 and therefore assert that the rejection is no longer applicable. Furthermore, it is respectfully submitted that Applicants’ specification enables one of ordinary skill in the art to make and use the claimed invention. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marshall et al.* and *Hill*. Applicants traverse this rejection for the following reasons.

In regards to proposed newly amended independent claims 1 and 5, Applicants respectfully assert that neither *Marshall et al.* nor *Hill* teach or suggest at least “said packing protection portion having a cross-section that is further from the longitudinal axis than a cross-section perpendicular to the longitudinal direction of the cover portion,” or similarly a “packing having a cross-section perpendicular to the longitudinal direction that is greater than a cross-section of the connector along the same direction,” as recited in claims 1 and 5, respectively.

Marshall et al. discloses a sealed waterproof connector assembly for interconnecting two or more electrical wires. The body 14 and cover 16 have complementary interchanging convolutions 40, 42 to retain the body and cover in an inter-engaged sealed condition. See the Abstract of *Marshall et al.*

Hill discloses a tethered protective cover which is detachably mounted to a multi-pin electrical connector. The cover includes a shroud which is mounted to the connector. A latch button on the intermediate shroud wall interacts with the projection on the connector to secure the shroud to the connector. See the Abstract of *Hill*.

Neither *Marshall et al.* nor *Hill*, alone or in combination, discloses the above-mentioned features as recited in independent claims 1 and 5. Further, because neither *Marshall et al.* nor *Hill* disclose the above-mentioned features recited in claims 1 and 5, each and every feature of the claims is not disclosed so that a *prima facie* case of obviousness has not been established.

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and therefore request that all rejections under 35 U.S.C. § 103(a) be withdrawn. To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, the Office Action does not establish a *prima facie* case of obviousness at least because it has not identified any suggestion or motivation to combine the cited reference teachings. Here, the suggestion or motivation to modify is not provided by either *Marshall et al.*, *Hill*, or by knowledge generally available to one of ordinary skill in the art, but by impermissible hindsight. In fact, as discussed during the personal interview, the Office Action erroneously combines *Marshall et al.* and *Hill* therein destroying the *Marshall et al.* reference. Applicants respectfully submit that there is no motivation to combine the references because the waterproof connector assembly of *Marshall et al.* would not function as originally intended (would not be waterproof) if improperly modified by *Hill* to include a front hole in its cover.

MPEP § 1504.03 states that “[i]f the proposed combination of the references so alters the primary reference that its broad function can no longer be carried out, the combination of the prior art would not have been obvious to a designer of ordinary skill in the art.” The

modification of *Marshall et al.* with the *Hill* reference effectively destroys the waterproof connector assembly function of *Marshall et al.* As such, there is no motivation to combine the references. Therefore, it is respectfully submitted that the conclusory statement regarding motivation in the Office Action is not sufficient by itself to establish *prima facie* obviousness.

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to *Marshall et al.* or to ordinary skill in the art to suggest the desirability of modifying *Marshall et al.* The mere assertion that *Marshall et al.* could be modified by what is ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.

Third, as demonstrated above, newly amended independent claims 1 and 5 disclose features not taught or suggested by either *Marshall et al.* or *Hill* alone or in combination. For at least these reasons, Applicants respectfully submit that claims 1-2 and 4-7 are allowable. Claims 2 and 4, and 6-7 are allowable at least because they recite the same combination of features as independent claims 1 and 5, respectively, as well as the additional features they recite that further distinguish them over the art of record. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of the

Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Attached hereto is a marked-up version of the changes made to the specification and claims by the current Amendment. The attached page is captioned "**VERSIONS WITH MARKINGS TO SHOW CHANGES MADE.**"

Respectfully submitted,

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MJB/DEC/fdb

VERSION WITH MARKINGS TO SHOW CHANGES MADE**IN THE CLAIMS:**

Claims 1 and 5 have been amended as follows:

1. (Four Times Amended) A dustproof cover comprising:

a cap-shape cover **portion** having ~~[an open end and]~~ a substantially closed end; and

a packing protecting portion ~~[provided by]~~ extending ~~[an end of an opening of a peripheral wall]~~ **from a peripheral wall of an opening** of said cover **portion** in a continual longitudinal direction, an inner surface of the cover **portion** includes a lip separating the packing protecting portion from the closed end of the cover **portion, said packing protection portion having a cross-section perpendicular to the longitudinal direction that is further from the longitudinal axis than a cross-section of the cover portion;**

wherein said cover **portion** has a hole in a front surface and an engaging projection provided on an inner surface of said peripheral wall of said cover **portion**, and said engaging projection is configured to engage with a lock arm provided on the outer periphery of a connector, said cover **portion** is fitted to said connector so as to cover a front~~[end fitting]~~ ~~[surface]~~ **portion and an outer peripheral portion** of said connector ~~[from a front side of said connector]~~ and said packing protecting portion covers a packing exposed around ~~[an]~~ **the** outer peripheral portion of said connector.

5. (Four Times Amended) A prefitted dustproofing structure comprising:

a connector provided with a packing exposed around an outer peripheral portion of a rear end of said connector and a plurality of electrical contacts located adjacent openings in a front ~~[side]~~ portion of the connector for electrical connection to mating electrical contacts of a mating connector, each of the plurality of contacts including one of a male connection structure and a female connection structure, the connector including at least one separate electrical conductor extending from the rear end of said connector, the connector extending in a direction away from the packing, and said packing having a ~~[greater]~~ cross-section~~[al diameter]~~ perpendicular to the longitudinal direction ~~[along a plane]~~ that is greater than a cross-section~~[al diameter]~~ of the connector along the same direction ~~[said plane]~~; and

a dustproof cover having a packing protecting portion ~~[provided by]~~ extending ~~[an end of an opening of a peripheral wall]~~ from a peripheral wall of an opening of a cover portion in a continual longitudinal direction,

wherein said dustproof cover is fitted to ~~[the outer periphery of]~~ said connector so as to cover ~~[a]~~ the front~~[end fitting surface]~~ portion and the outer peripheral portion of said connector with the cover portion ~~[from the front side of said connector]~~, and said packing protecting portion covers said packing.